

Notice of Allowability

Application No.

10/692,930

Applicant(s)

SHIMADA ET AL.

Examiner

Art Unit

Phyllis G. Spivack

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Amendment and Declaration filed January 13, 2006 and a Supplemental Response.
2. ☒ The allowed claim(s) is/are 19.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/486,823.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

16 April 2006

EXAMINER'S AMENDMENT

An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to Applicants, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

In the Abstract: X^2 is deleted and -- O -- is inserted therefor;

R^3 is deleted and -- CH₃ -- is inserted therefor;

R^2 is deleted and -- H₃C-CH₂- -- is inserted therefor;

X^1 is deleted and -- O -- is inserted therefor;

R^1 is deleted and -- H₃C-CH₂- -- is inserted therefor.

REASONS FOR ALLOWANCE

An Amendment and Declaration filed January 13, 2006 are acknowledged. A Supplemental Response filed February 2, 2006 is further acknowledged, in which a required signature to the Declaration provided on January 13, 2006, is noted.

Claim 19 is pending.

An amended Abstract and new title are further noted.

In the last Office Action claim 19 was rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to practice the invention. (The Examiner regrets the inadvertent omission of the number "9".) It was asserted Applicants failed to provide guidance as to how the therapeutic endpoint of the claimed method is achieved.

A Declaration provided by Shunji Ichikawa demonstrates in Table 1 that compound 1, which is (E)-1,3-dimethyl-8-(3,4-dimethoxystyryl)-7-methylxanthine, shows efficacy in protecting against cerebral ischemia in an animal model when compared to a control vehicle.

Accordingly, the rejection of record under 35 U.S.C. 112, first paragraph, is withdrawn.

Ongini et al., Annals of the New York Academy of Sciences is cited to show further the state of the art. Ongini teaches a therapeutic potential following administration of a homologous compound, designated KF 17837, an adenosine

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receptor agonist, in a model of cerebral ischemia. The publication date of the document is after Applicants' earliest priority date.

Claim 19 is allowed in view of the contemporary knowledge of the art.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Phyllis G. Spivack whose telephone number is 571-272-0585. The Examiner can normally be reached on 10:30 AM-7 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher Low can be reached on 591-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Phyllis G. Spivack
Primary Examiner
Art Unit 1614

**PHYLLIS SPIVACK
PRIMARY EXAMINER**

April 16, 2006